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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,827	12/28/2001	Akihiro Wada	217818US0CONT	5540

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EXAMINER
KEYS, ROSALYND ANN

ART UNIT	PAPER NUMBER
1621	

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/028,827	WADA ET AL.	
	Examiner	Art Unit	
	Rosalynd Keys	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 April 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6 and 8-13* is/are pending in the application.

4a) Of the above claim(s) *8-13* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-6 and 8-13* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *1,7 & 8* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Status of Claims

1. Claims 1-6 and 8-13 are pending.

Claims 1-6 are

Claims 8-13 are withdrawn from consideration.

Election/Restrictions

2. Applicant's election with traverse of Group I, claims 1-6 in Paper No. 11 is acknowledged. The traversal is on the ground(s) that 1) the PTO has failed to provide evidence and/or examples to show that the inventions of Groups I and III are novel and unobvious over each other and capable of separate manufacture, use, or sale; 2) with respect to Groups II and III, the PTO has not provided any evidence to show that the claimed product can be made by another and materially different process; and 3) the PTO has failed to provide evidence and/or examples to show that the inventions of Groups I and II are novel and unobvious over each other and capable of separate manufacture, use, or sale. This is not found persuasive because 1) the fluoroalkanol that is produced by the method of Group I does not have to be used to make an information recording medium. The fluoroalkanol of Group I can be utilized in a manner other than the claimed use (see column 1, lines 35-44 of U.S. Patent No. 4,346,250 issued to Satokawa et al.); 2) information recording mediums can be

coated using solvents other than the claimed fluoroalkanol (see for example the paragraph bridging pages 9and 10 of EP0130399, wherein the solvent is a selected from acetone methyl ethyl ketone, etc.); and 3) fluoroalkanols can be used to make other than an information recording medium and information recording mediums can be made from materials other than fluoroalkanols. The Examiner believes that Groups I-III have been shown to be distinct and a restriction is proper as is shown by their separate classification.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 8-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 11.

Priority

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

5. The information disclosure statements filed December 28, 2001; August 15, 2002; and October 18, 2002 have been considered.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joyce, Jr. (U.S. Patent No. 2,559,628) in view of Knaup (U.S. Patent No. 5,227,540).

The instant invention is directed to a process of preparing a fluoroalkanol having the claimed formula 1 by reacting an alkanol having the claimed formula 2 with a perfluoroolefin having the claimed formula 3, wherein the reaction is carried out while continuously adding a radical initiator, in particular a dialkyl peroxide, and a perfluoroolefin having the claimed formula 3.

Joyce, Jr. teach preparing a fluoroalkanol having the claimed formula 1 by reacting an alkanol having the claimed formula 2 with a perfluoroolefin having the claimed formula 3 in the presence of a catalyst (radical initiator) such as, diethyl peroxide (see entire document, in particular column 2, line 52 to column 3, line 7 and column 7, line 54 to column 9, line 64).

Joyce, Jr. differ from the instant invention in that Joyce do not teach carrying out the reaction while continuously adding the radical initiator and perfluoroolefin.

Knaup teaches preparing a fluoroalkanol by reacting alkanol with a perfluoroolefin, wherein the perfluoroolefin and a radical initiator are continuously added (see entire disclosure, in particular column 1, line 58 to column 3, line 68). Knaup teaches that his process allows one to obtain the

target fluoroalkanol in high yield and high purity as compared to a method wherein all the ingredients are added at once.

One having ordinary skill in the art at the time the invention was made would have been motivated to continuously add the radical initiator and perfluoroolefin of Joyce, Jr. in the manner as taught by Knaup in order obtain the fluoroalkanol of Joyce, Jr. in high yield and high purity.

The skilled artisan would have a reasonable expectation of success, since the starting materials and products of Joyce, Jr. are analogous to the starting materials and products of Knaup.

10. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knaup (U.S. Patent No. 5,227,540).

Knaup teaches preparing a fluoroalkanol by reacting alkanol with a perfluoroolefin, wherein the perfluoroolefin and a radical initiator are continuously added (see entire disclosure, in particular column 1, line 58 to column 3, line 68). The radical initiators disclosed include dialkyl peroxides (see column 3, lines 56-63). Alkanols disclosed include methanol and ethanol (see column 3, lines 46-48). The claims differ from Knaup only by employing a different perfluoroolefin as starting material. However, the starting materials are analogous in that they are both perfluoroolefins. One having ordinary skill in the art at the time the invention was made would have been motivated to employ the process of Knaup with the expectation of obtaining the desired product

because the skilled artisan would have expected the analogous starting materials to react similarly.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynd Keys whose telephone number is 703-308-4633. The examiner can normally be reached on M and F 3:00-8:00 pm and T-R 5:30-10:30 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 703-308-4532. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Rosalynd Keys
Primary Examiner
Art Unit 1621

R. Keys
August 1, 2003